



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,391	02/11/2004	Mitchell A. Altman	BIGTOE.003A	3924
20995	7590	05/31/2006	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			HOLLOWAY III, EDWIN C	
			ART UNIT	PAPER NUMBER
			2612	

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/776,391	ALTMAN, MITCHELL A.	
	Examiner	Art Unit	
	Edwin C. Holloway, III	2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 March 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3, 7-15, 17-28 and 31-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3, 7-15, 17-28 and 31-42 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

Art Unit: 2612

EXAMINER'S RESPONSE

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3-16-06 has been entered. The examiner has considered the new presentation of claims and applicant's arguments in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 8 and 20-28, 31-39 and 42 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a

Art Unit: 2612

way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The public place in claims 20, 35 and 36 is not disclosed. Claims 8 and 34 can be interpreted as claiming that the transmitter is a stereo or video player, but such is not disclosed.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 8 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The device being a stereo or video player in claims 8 and 34 is unclear because the controlled device in claim 1 has been replaced with a television.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-2, 7, 15, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667) in combination with Fridley (US 6005486) and Rumbolt (US 4703359).

Regarding claim 1, Enomoto discloses a universal remote

Art Unit: 2612

control device 1 for effecting a function of a remotely controlled device including actuator (buttons or keys 2/3) to cause emitting of encoded signals from a database is disclosed in col. 3 lines 25-32 and col. 5 lines 42-56. The database of encoded signals for effecting control of a plurality of different device in the form of a lookup table in ROM 64 disclosed in col. 6 lines 45-53. An emitter 82 to emit the encoded signals is disclosed in col. 6 lines 54-68. Enomoto does not expressly disclose a housing, no more than 1/2 second between signals and twenty controlled devices.

Fridley discloses transmitting a sequence or cluster of signals with 40 ms (less than 1/10 sec or 100 ms) delay between command in col. 19 lines 12-22.

Rumbolt is referred to by Enomoto for disclosing the code ROM. Rumbolt disclosed in col. 7 line 50 that the ROM includes data for most widely used formats. This would obviously include at least 20 signals.

Regarding claim 1, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Enomoto a housing for the transmitter because this is suggested by the transmitter structure shown in fig. 1 and described in col. 4 lines 4-5 as a low profile card shape and housings are well known in the art for holding the remote

Art Unit: 2612

controller circuit. Although Enomoto shows only 3 devices, the limitation of 20 devices and signals would have been obvious in view of the reference to "several devices" in col. 6 line 9 of Enomoto indicating that the remote controller of Enomoto is capable of controlling 20 different devices in range and because col. 4 lines 11-26 of Enomoto refers to Rumbolt for the code ROM where in Rumbolt the ROM includes formats for most widely used appliances that would obviously include 20 codes. The less than 1/2 second between signals would have been obvious in view of the 40ms delay in Fridley rapid and flexible operation and suggested by the short spaces between signals in fig. 1 of Enomoto.

Regarding claim 2, the function of Enomoto includes OFF in col. 5 line 48.

Regarding claim 7, the controlled devices are television sets in col. 4 line 4 line 9 of Enomoto.

Regarding claim 15, emitter 82 of Enomoto is an infrared LED in col. 6 lines 59-60.

Regarding claim 40, Enomoto discloses transmitting the signal 3 times, but Fridley discloses transmitting a sequence or cluster of signals only once for eliminating a selection switch for rapid operation. See col. 9 line 48 - col. 10 line 9 and col. 12 lines 16-34.

Art Unit: 2612

8. Claims 3, 18 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667), Fridley (US 6005486) and Rumbolt (US 4703359) as applied above and further in view of Murray (US 6778380B2).

Regarding claim 3, Enomoto discloses volume decrement control in col. 3 line 68, but lacks mute control. Murray discloses a television remote control device and method with a single function of mute to overcome the distraction of a TV when communicating to a nearby person in col. 1 lines 15-25. The single function transmitter is small and inexpensive. See col. 2 lines 27-60. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the mute function Murray in the combination applied above to toggle between reduced and normal sound level, suggested by the volume decrement of Enomoto to reduce distractions

Regarding claims 18 and 32, a single function remote would have been obvious in view of Murray to provide a small and inexpensive remote.

9. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667), Fridley (US 6005486), Rumbolt (US 4703359) and Murray (US 6778380B2) as applied above and further in view of Carlsgaard (US 20020186320A1).

Art Unit: 2612

The combination applied above has mute, but not closed caption.

Carlsgaard discloses providing closed captioning automatically with a mute command in paragraph 0025. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the closed caption function in the combination applied above in view of Carlsgaard disclosing automatically providing closed caption with the mute command.

10. Claims 8-14 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667), Fridley (US 6005486) and Rumbolt (US 4703359) as applied above in view of Emmons (US 5243430).

Emmons discloses a remote control for plural devices with a circular housing with buttons and multiple light emitting diodes for omnidirectional transmission of control signals, so the remote need not be pointed or have line of sight to the controlled device. See col. 1 line 49 - col. 2 line 7 and col. 2 lines 27-49.

Regarding claims 9-14, the circular housing of Emmons generally resembles a smiley face with a buttons 22a,b in the general area of the nose and multiple emitters 50 generally in the area of the eyes and it would have been obvious to one of

Art Unit: 2612

ordinary skill in the art at the time the invention was made to have included the housing Emmons in the combination applied above to allow operation without accurate pointing or line of sight.

Regarding claims 8 and 34, control of a VCR would have been obvious in view of Emmons including VCR control suggested by Enomoto disclosing control of video devices and including a TV/VTR key in col. 4 line 1.

11. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667), Fridley (US 6005486) and Rumbolt (US 4703359) as applied above and further in view of van Ee (US 6208341B1).

Van Ee discloses a remote control where a programmable delay of 0.1 to 99.9 seconds is provided between commands in col. 2 lines 20-40. A delay of 0.5 seconds is default, but can be changed as desired in col. 4 lines 8-48. The 1/4 to 1/2 second delay of claim 17 would have been obvious in the combination applied above because Van Ee discloses a programmable delays in remote transmitter covering this range to allow desired delays and is suggested by col. 19 lines 34-39 of Fridley disclosing that various different delays may be used.

12. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667), Fridley (US 6005486) and

Art Unit: 2612

Rumbolt (US 4703359) as applied above and further in view of Herweck (US 5731763). Herweck discloses a TV remote controller with a key chain housing in fig. 3A and col. 6 line 41 - col. 7 line 3 that would have been obvious in the combination applied above to allow small size.

13. Claims 20-24, 26-28, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667) in combination with Fridley (US 6005486), Rumbolt (US 4703359) and Mullaly (US 6567032B1).

Mullaly discloses a pointing remote control for use in a public place with out pre-programming in col. 8.

Regarding claim 20, Enomoto discloses a method of effecting a function of a remotely controlled device including pointing a universal remote device 1 in the direction of (directed toward) the remotely controlled device in col. 3 lines 25-32 and col. 5 lines 42-56. The remote device includes a database of encoded signals for effecting control of a plurality of different device in the form of a lookup table in ROM 64 disclosed in col. 6 lines 45-53. Actuating an actuator (operating/depressing keys 2/3) to cause emitting of the encoded signals from the database is disclosed in col. 3 lines 25-32 and col. 5 lines 42-56. Emitting the encoded signals by an emitter 82 is disclosed in col. 6 lines 54-68. Enomoto lacks the claimed time between

Art Unit: 2612

signals, but this would have been obvious in view of Fridley for the reasons applied above. Enomoto does not expressly disclose 20 controlled devices, but this difference would have been obvious in view of Rumbolt or the same reasons applied above. Enomoto lacks reference to public place, but this would have been obvious in view of Mullaly disclosing the desirability of using a remote control in a public place without pre-programming and because the codes of Enomoto would not know they are being used in a public place.

Regarding claim 21 and 39, Enomoto discloses transmitting the signal 3 times, but Fridley discloses transmitting a sequence or cluster of signals only once for eliminating a selection switch very rapid operation. See col. 9 line 48 - col. 10 line 9 and col. 12 lines 16-34. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Enomoto the emission of the cluster only once as disclosed in Fridley for rapid operation.

Regarding claim 22, emitter 82 of Enomoto is an infrared LED in col. 6 lines 59-60.

Regarding claim 23, pointing at a second device and repeating the actuating and emitting steps is disclosed in col. 5 lines 57-66 of Enomoto.

Art Unit: 2612

Regarding claims 24, the function includes OFF in col. 5 line 48 of Enomoto.

Regarding claim 26-28, repeating the operation to reverse the function between ON and OFF is disclosed in col. 12 lines 49-57 of Fridley and it would have been obvious to have included this operation in Enomoto because the "ON or OFF" function in Enomoto suggests this toggle operation and col. 12 lines 49-57 of Fridley states that this is common in TV codes.

14. Claims 25 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667) in combination with Fridley (US 6005486), Rumbolt (US 4703359) and Mullaly (US 6567032B1) as applied above and further in view of Murray (US 6778380B2).

Regarding claim 25, Enomoto discloses volume decrement control in col. 3 line 68, but lacks mute control. Murray discloses a television remote control device and method with a single function of mute to overcome the distraction of a TV when communicating to a nearby person in col. 1 lines 15-25. The single function transmitter is small and inexpensive. See col. 2 lines 27-60. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the mute function Murray in the combination applied above to toggle between reduced and normal sound level,

Art Unit: 2612

suggested by the volume decrement of Enomoto to reduce
distractions

Regarding claims 33, a single function remote would have been obvious in view of Murray to provide a small and inexpensive remote.

15. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667), Fridley (US 6005486), Rumbolt (US 4703359), Mullaly (US 6567032B1), and Murray (US 6778380B2) as applied above and further in view of Carlsgaard (US 20020186320A1).

The combination applied above has mute, but not closed caption.

Carlsgaard discloses providing closed captioning automatically with a mute command in paragraph 0025. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the closed caption function in the combination applied above in view of Carlsgaard disclosing automatically providing closed caption with the mute command.

16. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667), Fridley (US 6005486), Rumbolt (US 4703359) and Mullaly (US 6567032B1), as applied above and further in view of van Ee (US 6208341B1).

Art Unit: 2612

Van Ee discloses a remote control where a programmable delay of 0.1 to 99.9 seconds is provided between commands in col. 2 lines 20-40. A delay of 0.5 seconds is default, but can be changed as desired in col. 4 lines 8-48. The 1/4 to 1/2 second delay of claim 17 would have been obvious in the combination applied above because Van Ee discloses a programmable delays in remote transmitter covering this range to allow desired delays and is suggested by col. 19 lines 34-39 of Fridley disclosing that various different delays may be used.

17. Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667) in combination with Rumbolt (US 4703359), Mullaly (US 6567032B1) and Murray (US 6778380B2).

Mullaly discloses a pointing remote control for use in a public place without pre-programming in col. 8.

Regarding claims 35-37, Enomoto discloses a method of effecting a function of a remotely controlled device including pointing a universal remote device 1 in the direction of (directed toward) the remotely controlled device in col. 3 lines 25-32 and col. 5 lines 42-56. The remote device includes a database of encoded signals for effecting control of a plurality of different device in the form of a lookup table in ROM 64 disclosed in col. 6 lines 45-53. Actuating an actuator

Art Unit: 2612

(operating/depressing keys 2/3) to cause emitting of the encoded signals from the database is disclosed in col. 3 lines 25-32 and col. 5 lines 42-56. Emitting the encoded signals by an emitter 82 is disclosed in col. 6 lines 54-68. Enomoto does not expressly disclose 20 controlled devices, but this difference would have been obvious in view of Rumbolt or the same reasons applied above. Enomoto lacks reference to public place, but this would have been obvious in view of Mullaly disclosing the desirability of using a remote control in a public place without pre-programming and because the codes of Enomoto would not know they are being used in a public place. Enomoto lacks the minimize disturbance of claim 35 and mute of claim 36, but Enomoto discloses volume decrement control in col. 3 line 68, but lacks mute control. Murray discloses a television remote control device and method with a single function of mute to overcome disturbance of a TV during load commercials or when communicating to a nearby person in col. 1 lines 15-25. The single function transmitter is small and inexpensive. See col. 2 lines 27-60. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the minimizing of disturbance and mute function Murray in the combination applied above to toggle between reduced and normal sound level, suggested by the volume decrement of Enomoto

Art Unit: 2612

to reduce distractions with a small and inexpensive remote.

Regarding claims 33, a single function remote would have been obvious in view of Murray to provide a small and inexpensive remote.

18. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enomoto (US 5128667), Rumbolt (US 4703359), Mullaly (US 6567032B1), and Murray (US 6778380B2) as applied above and further in view of Carlsgaard (US 20020186320A1).

The combination applied above has mute, but not closed caption.

Carlsgaard discloses providing closed captioning automatically with a mute command in paragraph 0025. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the closed caption function in the combination applied above in view of Carlsgaard disclosing automatically providing closed caption with the mute command.

Response to Amendment

19. The declaration under 37 CFR 1.132 filed 3-16-06 is insufficient to overcome the rejection of claims 1-3 and 7-34 based upon prior art as set forth in the last Office action because: There is no clear nexus between the declaration and the claims. See MPEP 716.03 Commercial success must be

Art Unit: 2612

commensurate with the scope of the claims. Evidence of commercial success that broadly covers the claims is not commensurate with the scope of the claims. See MPEP 716.03(a) The device in the declaration is for TV, but claim 20 is not limited to this. The device in the declaration includes 117 codes, but the claims and specification are not limited to this. 117 codes may broadly include the 20 codes of the claims, but 117 is significantly larger. This is not commensurate with the scope of the claims. The device in the declaration has a timing of 205 m sec, but claims 35-38 do not specify timing and 205 ms is not in the range of claims 17 and 31. There is no comparison to the sales of other universal remotes. See MPEP 716.03 IV. The claimed limitations are properly rejected as unpatentable over the prior art.

Response to Arguments

20. Applicant's arguments filed 3-16-05 have been fully considered but they are not persuasive or are moot in view of the new grounds of rejection. The argument that "at least twenty devices" is a critical parameter to allow control of a majority of televisions is not persuasive because this would have been obvious in view of Enomoto referring to Rumbolt for the code ROM and Rumbolt disclosing a universal remote with ROM having codes for most widely used appliances. A "universal"

Art Unit: 2612

remote would need to operate a majority of TV's to be "universal" and inherently include 20 codes. The 1/4 to 1/2 second range would have been obvious in view of van Ee and is not covered by applicant's declaration. The problem of having a conversation and the no more than two functions is obvious in view of Murray. Lack of marketing does make alone make a clear nexus. Proof that the commercial success is attributed to the claimed limitations is needed. Further, the newspaper and magazine articles amount to free advertisement that would increase sale even if applicant did not pay for marketing.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kubo (US005132679A) discloses a remote control with 0.2 sec minimal transmit interval in col. 6.

CONTACT INFORMATION

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at ebc@uspto.gov. The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications.

Art Unit: 2612

Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.

Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600.

Facsimile submissions may be sent via central fax number 571-273-8300 to customer service for entry by technical support staff. Questions related to the operation of the facsimile system should be directed to the Electronic Business Center at (866) 217-9197. On July 15, 2005, the Central FAX Number will change to.

CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number. Inquiries concerning only hours and location of the Customer Window may be directed to OIPE Customer Service at (703) 308-1202.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (571) 272-7308.



EDWIN C. HOLLOWAY, III
PRIMARY EXAMINER
ART UNIT 2612

EH

5/25/06